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DAVIS WRIGHT TREMAINE, LLP/Seattle 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			EXAMINER SAMS, MATTHEW C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/006,936

Applicant(s)

CHIEN, HERMAN

Examiner

Matthew C. Sams

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4-8, 10, 17, 20-25, 27-33 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8, 10, 17, 20-25, 27-33 and 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2007 has been entered.
2. Claims 11, 14-16, 18 and 19 are canceled. Claims 35-38 have been added.

### ***Response to Amendment***

3. This office action has been changed in response to the amendment filed on 10/29/2007.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 4-8, 27, 28, 30-33 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Peck (US-6,606, 491).

Regarding claim 4, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) for use with a network, the communication device comprising:

- a device identifier; (Col. 3 lines 51-53 terminal based ESN)

- a register configured to store a user identifier (Col. 3 lines 13-15 SIM-based ESN), the user identifier being unrelated to the device identifier; (Col. 3 lines 51-57)

- a transmitter configured to transmit the user identifier to the network; (Fig. 2 [54] and Col. 3 lines 51-57) and

- a SIM card (Fig. 2 [90]) comprising a SIM identification number that, at least in part, was assigned to the SIM by a manufacturer of the SIM (Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer"), wherein the user identifier is associated with the serial number. (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33)

Regarding claim 5, Peck teaches a communication device (Fig. 1 [24] and Fig. 2) comprising a processor (Fig. 2 [68]) configured to encrypt the user identifier before transmission to the communication network. (Col. 2 lines 12-61 and Col. 7 lines 36-49)

Regarding claim 6, Peck teaches a processor (Fig. 2 [68]) and a user input interface configured to supply commands to the processor. (Fig. 2 [76])

Regarding claim 7, Peck teaches a cellular telephone for use with a network, the cellular telephone comprising:

- a memory configured to store a device identifier; (Col. 2 lines 37-39 IMEI)

a display (Fig. 2 [78]) configured to display data and commands; (Col. 6 lines 25-34)

a user input interface for data entry and command entry; (Fig. 2 [76]), a SIM (Fig. 2 [90])

a subscriber identity module have a SIM serial number (Col. 2 lines 49-61 and Col. 3 lines 51-57) that, at least in part, was assigned to the SIM by a manufacturer of the SIM; (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") and

a transmitter configured to receive transmit commands issued by the processor, and to transmit the user identifier to network following receipt of a transmit command issued by the processor. (Fig. 2 [54], Col. 7 lines 36-49 and Col. 10 lines 20-25)

Regarding claim 8, Peck teaches a cell phone (Fig. 2) wherein the transmitter is configured to transmit the device identifier to the network following receipt of a transmit command issued by the processor. (Col. 3 lines 16-20)

Regarding claim 27, Peck teaches a register configured to store a mobile station number and the transmitter is configured to transmit the mobile station number and the user identifier to a network. (Col. 1 lines 33-54, Col. 3 lines 9-15 and Col. 10 lines 5 & 20-25)

Regarding claim 28, Peck teaches a mobile station number is a mobile station phone number which is the same as the MSISDN number. (Col. 1 lines 33-54)

Regarding claim 30, Peck teaches a register configured to store a mobile subscriber identity and the transmitter is configured to transmit the mobile subscriber identity to the network. (Col. 2 lines 30-61)

Regarding claim 31, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Col. 2 lines 30-48)

Regarding claim 32, Peck teaches the register is further configured to store a mobile subscriber identity (Col. 2 lines 39-42) and a mobile station number (Col. 1 lines 38-39 MIN) and the transmitter is configured to transmit the mobile subscriber identity, the mobile station number and the user identifier to the network. (Col. 1 lines 49-54, Col. 2 lines 42-57 and Col. 3 lines 51-57)

Regarding claim 33, Peck teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI) and the mobile station number is a mobile station ISDN number (MSISDN). (Col. 2 lines 30-48) It is well known to one of ordinary skill in the art that the MSISDN is the telephone number of the SIM card, including the country code.

Regarding claim 35, Peck teaches the communication device of claim 4 associated with a mobile telephone number (Col. 2 lines 30-48), wherein the user identifier is unrelated to the mobile telephone number. (Col. 10 lines 20-25)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 17, 20-25 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (US-6,310,889 hereafter, Parsons) in view of Peck.

Regarding claim 10, Parsons teaches a content provider configured to communicate with one or more mobile stations (Col. 1 line 54 through Col. 2 line 32), the content provider comprising:

a content personalization interface configured to receive the anonymous user identifier from at least one of the mobile stations (Col. 8 lines 56-61) and

a processor configured to use the anonymous user identifier to personalize content for the at least one of the mobile stations, and to provide the personalized content to the at least one of the mobile stations. (Col. 8 line 56 through Col. 9 line 29) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not explicitly reciting the user identifier is based on a SIM serial number, unrelated to the device identifier and associated with the SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines

50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as a user identifier (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) that is unrelated to the device identifier. (Col. 3 lines 51-57) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Regarding claim 17, Parsons in view of Peck teaches a personalization interface is configured to receive the device identifier and the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 20, Parsons in view of Peck teaches the anonymous user identifier is the SIM serial number (Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) assigned, at least in part, by the manufacturer of the SIM. (Peck Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")



Regarding claim 21, the limitations of claim 21 are rejected as being the same reason set forth above in claim 10.

Regarding claim 22, Parsons in view of Peck teaches the selected anonymous user identifier is the serial number of the SIM card. (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 23, the limitations of claim 23 are rejected as being the same reason set forth above in claim 17.

Regarding claim 24, Parsons in view of Peck teaches wherein the content provider has a plurality of user profiles, each user profile of the plurality of user profiles having a device identifier and an anonymous user identifier, the method further comprising at the content provider:

selecting a user profile from the plurality of user profiles, the selected user profile having a device identifier identical to the device identifier of the wireless device and an anonymous user identifier identical to the anonymous user identifier of the wireless device; (Parsons Col. 8 lines 56 through Col. 9 line 3, Col. 14 lines 34-48 and Peck Col. 1 lines 37-39 and Col. 7 line 36 through Col. 8 line 11) and

selecting content based on the selected user profile. (Parsons Col. 14 lines 34-48, Peck Col. 2 lines 12-61, Col. 3 lines 51-57 and Col. 4 lines 53-62)

Regarding claim 25, Parsons in view of Peck teaches a method of using a wireless device comprising a device identifier (Peck Col. 3 lines 51-53 terminal based

ESN) and a subscriber identity module (SIM) have a serial number assigned, at least in part, by a manufacturer of the SIM (Peck Col. 8 lines 50-52) to obtain anonymous personalized content from a content provider (Parsons Col. 8 lines 56-61), the method comprising:

by selecting an anonymous user identifier based, at least in part, on a serial number assigned by a SIM manufacturer; (Peck Col. 3 lines 51-57, Col. 4 lines 53-62, Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

providing the anonymous user identifier to the content provider; (Parsons Col. 8 line 56 through Col. 9 line 29)

waiting for the content server to send anonymous personalized content identified by the content provider based on the anonymous user identifier for delivery to the wireless device; (Parsons Col. 1 line 59 through Col. 2 line 32 and Col. 8 line 56 through Col. 9 line 3) and

receiving the anonymous personalized content from the content provider. (Parsons Col. 14 lines 40-44)

Regarding claim 36, Parsons in view of Peck teaches the transmitter is configured to receive a request for additional identification information from the network, to communicate the request to the processor, and following receipt of a transmit response command from the processor, to transmit a response to the request to the network, (Parsons Col. 5 lines 19-31)

following communication of the request to the processor, the processor is configured to issue a display command directing the display to display the request, (Parsons Col. 5 lines 19-20)

the display is configured to receive the display command from the processor and following receipt of the display command, to display to the user the request received by the transmitter from the network, (obvious, otherwise the user doesn't know to login using their user ID and password Parsons Col. 5 lines 20-21)

the user input interface is configured to receive a response from the user to the request displayed to the user and to provide the response to the processor, (obvious otherwise the user will never be logged in) and

the processor is configured to issue the transmit response command to the transmitter directing the transmitter to transmit the response to the network. (Parsons Col. 5 lines 29-31)

Regarding claim 37, Parsons in view of Peck teaches the content personalization interface is configured to receive the anonymous personalization data from the at least one of the mobile stations; (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21) and

the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations. (Parsons

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Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and  
Col. 5 lines 18-21)

Regarding claim 38, Parsons in view of Peck teaches a database (Parsons Fig. 3 [38a & 38b]) configured to store the anonymous personalization data received by the content personalization interface from the at least one of the mobile stations and to provide the anonymous personalization data to the processor. (Parsons Col. 9 lines 4-29 and Col. 14 lines 40-44)

  
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PATENT OFFICE PRIMARY EXAMINER